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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/713,965	11/15/2000	David R. Scott	277-P-32-USA	5189
7590	12/28/2005		EXAMINER	
Drummond & Duckworth 4590 MacArthur Blvd Suite 500 Newport Beach, CA 92660			BLECK, CAROLYN M	
			ART UNIT	PAPER NUMBER
			3626	

DATE MAILED: 12/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/713,965

Applicant(s)

SCOTT, DAVID R.

Examiner

Carolyn M. Bleck

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the amendment filed 5 October 2005.

Claims 8-12 are newly added. Claims 1-7 have been cancelled.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 8-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 8 and 12 recite the rescue mission provision "providing for the payment for initiation of a rescue mission, as opposed to simply paying out money to the insured." It is unclear how providing for payment for initiation of a rescue mission is not a form of paying out money to the insured. It would appear that the payment for initiation of a rescue mission would have to include paying money to the insured because the insured would have to coordinate the rescue mission. If no money is paid to the insured, it would appear some other party is coordinating the rescue mission. If Applicant intends for a specific party to receive the payment for initiation of a rescue mission other than the insured, Applicant should recite this in the claim. In addition, if

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Applicant is attempting to recite that the money paid to the insured be used solely or only to rescue the satellite, Applicant should consider reciting this in the claim.

Claims 8 and 12 recite "unintentionally launching the satellite." It is unclear to the Examiner how a satellite can be unintentionally launched. It appears that the satellite can be launched into a unintentional orbit, but this would not be an unintentional launch of a satellite. The launching of the satellite was intentional. Clarification is requested.

Claims 9-11 incorporate the deficiencies of claim 8, and are therefore rejected for the same reasons as claim 8.

Claim Rejections - 35 USC § 101

4. The rejection under 35 USC 101 is hereby withdrawn due to the cancellation of claims 1-7.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 8, 11, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Otis (L.H. Otis, *Insured Satellite 'Reboost' is a First*, National Underwriter, vol. 95, issue 16, April 1991, pp. 7-9) in view of Borghesi et al. (5,950,169).

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(A) As per claim 8, Otis discloses a method of insuring through coverage for the in-space recovery and "reboost" of a satellite (par. 2) comprising:

(a) acquiring a satellite for orbiting the earth by INTELSTAT (see discussion of INTELSTAT VI (F-3) for providing worldwide telecommunications services) (par. 3-4) (It is respectfully submitted that Hughes Aircraft built the INTELSTAT VI which INTELSTAT then acquired which is considered to be a form of purchasing);

(b) obtaining a risk management package encompassing two separate but overlapping coverages in one policy, wherein the first portion of the coverage insures the satellite in low orbit and until its recovery by the NASA space shuttle, and wherein the second phase of coverage encompasses the operation of placing the satellite into the cargo hold of the space shuttle, refitting it with a new perigee motor, and the reboost of it into its final operational orbit (par. 7-8) (It is respectfully submitted that this provision of the Otis article would cover the launch of the satellite into an unintended orbit (i.e., if the rescue mission of the INTELSTAT VI fails because the satellite is re-launched into an unintended orbit, then the policy would cover this failure (par. 12)); and

(c) launching a satellite into a non-operational lower orbit (par. 2-8); and

(d) initiating a rescue/ recovery mission to move the satellite from a non-operational lower orbit to a final operational orbit (par. 2-8).

Otis fails to expressly disclose the provision providing for the payment for initiation of a rescue mission as opposed to simply paying out money to the insured, in the event that the satellite is launched into an unintended orbit, and paying for the initiation of a rescue mission by the guarantor.

While the Examiner recognizes that Borghesi is not directed to satellite insurance *per se*, the Examiner respectfully submits that Borghesi is a form of analogous art. It is well known in the art of automobile insurance that a person can obtain an insurance policy which provides coverage in the event an insured's automobile is damaged, destroyed, or lost through fire, theft, vandalism, and collision. When the policy holder gets into an accident, the policy holder files an insurance claim with the insurer. Borghesi teaches that the insurer pays the insured the cost of repairing the car (col. 5 lines 15-25). If the car is a total loss, the person is paid the total loss amount. The concept of paying for the repair cost of the car or other property is analogous to Applicant's provision of providing payment for the initiation of a rescue mission by a guarantor. If an insurer can salvage the car or in this case, a satellite, by repairing the car or satellite at a cost that is less than the total loss amount of the car or satellite, the insurer should perform this repair. If the cost to rescue or repair is greater than the total loss amount, then the insurer will not perform the repair or rescue.

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the features of Borghesi within the method of Otis with the motivation of ensuring that the repair costs of the property are not exceeding the total loss valuation of the property (col. 2 lines 50-60), thus allowing insurance companies to repair property rather than declare it a total loss, and thus increasing profitability of the insurance company.

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(B) As per claim 11, Otis discloses obtaining an insurance policy that provides coverage that encompasses the operation of placing the satellite into the cargo hold of the space shuttle, refitting it with a new perigee motor, and the reboost of it into its final operational orbit, wherein any failures during this phase of coverage are covered by the insurance policy (i.e., failing to reboost it into its final operational orbit) (par. 7-8, 11).

(C) As per claim 12, Otis discloses a method of insuring through coverage for the in-space recovery and "reboost" of a satellite (par. 2) comprising:

(a) acquiring a satellite for orbiting the earth by INTELSTAT (see discussion of INTELSTAT VI (F-3) for providing worldwide telecommunications services) (par. 3-4) (It is respectfully submitted that Hughes Aircraft built the INTELSTAT VI which INTELSTAT then acquired which is considered to be a form of purchasing);

(b) obtaining a risk management package encompassing two separate but overlapping coverages in one policy, wherein the first portion of the coverage insures the satellite in low orbit and until its recovery by the NASA space shuttle, and wherein the second phase of coverage encompasses the operation of placing the satellite into the cargo hold of the space shuttle, refitting it with a new perigee motor, and the reboost of it into its final operational orbit (par. 7-8) (It is respectfully submitted that this provision of the Otis article would cover the launch of the satellite into an unintended orbit (i.e., if the rescue mission of the INTELSTAT VI fails because the satellite is re-launched into an unintended orbit, then the policy would cover this failure (par. 12));

(c) launching a satellite into a non-operational lower orbit (par. 2-8); and

(d) initiating a rescue/ recovery mission to move the satellite from a non-operational lower orbit to a final operational orbit (par. 2-8);

(e) obtaining an insurance policy that provides coverage that encompasses the operation of placing the satellite into the cargo hold of the space shuttle, refitting it with a new perigee motor, and the reboost of it into its final operational orbit, wherein any failures during this phase of coverage are covered by the insurance policy (i.e., failing to reboost it into its final operational orbit) (par. 7-8, 11) (reads on "rescue mission failure insurance policy");

(f) initiating a rescue mission by attempting to reboost the satellite into its final operation orbit and having the rescue mission fail (par. 3-8, 11, 23); and

(g) providing financial compensation for the loss of the satellite by the insurer to INTELSTAT if the rescue mission fails (par. 3-8, 11, 23).

Otis fails to expressly disclose the provision providing for the payment for initiation of a rescue mission as opposed to simply paying out money to the insured, in the event that the satellite is launched into an unintended orbit, and paying for the initiation of a rescue mission by the guarantor.

While the Examiner recognizes that Borghesi is not directed to satellite insurance *per se*, the Examiner respectfully submits that Borghesi is a form of analogous art. It is well known in the art of automobile insurance that a person can obtain an insurance policy which provides coverage in the event an insured's automobile is damaged, destroyed, or lost through fire, theft, vandalism, and collision. When the policy holder gets into an accident, the policy holder files an insurance claim with the insurer.

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Borghesi teaches that the insurer pays the insured the cost of repairing the car (col. 5 lines 15-25). If the car is a total loss, the person is paid the total loss amount. The concept of paying for the repair cost of the car or other property is analogous to Applicant's provision of providing payment for the initiation of a rescue mission by a guarantor. If an insurer can salvage the car or in this case, a satellite, by repairing the car or satellite at a cost that is less than the total loss amount of the car or satellite, the insurer should perform this repair. If the cost to rescue or repair is greater than the total loss amount, then the insurer will not perform the repair or rescue.

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the features of Borghesi within the method of Otis with the motivation of ensuring that the repair costs of the property are not exceeding the total loss valuation of the property (col. 2 lines 50-60), thus allowing insurance companies to repair property rather than declare it a total loss, and thus increasing profitability of the insurance company.

7. Claims 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Otis (L.H. Otis, *Insured Satellite 'Reboost' is a First*, National Underwriter, vol. 95, issue 16, April 1991, pp. 7-9) and Borghesi et al. (5,950,169) as applied to claim 8, and further in view of Scott (5,806,802).

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(A) As per claim 9, Otis discloses insurance coverage for the operation of placing the satellite into the cargo hold of the space shuttle, refitting it with a new perigee motor, and the reboost of it into its final operational orbit (par. 7-8)

Otis and Borghesi fail to expressly disclose the provision for the guarantor initiating a recovery mission including “providing for moving an unmanned extension spacecraft within proximity of the orbiting satellite, mechanically connecting the extension spacecraft to the orbiting satellite to form a docked satellite-spacecraft combination, and moving the satellite-spacecraft combination using the control systems of the extension spacecraft”.

Scott discloses providing for launching a SIRE spacecraft, which is unmanned, from earth within proximity of the orbiting satellite, docking the SIRE spacecraft with the target satellite to create a docked combination, and moving the combination using control system of the SIRE spacecraft (Fig. 1-4b, col. 1 lines 22-33, col. 6 line 63 to col. 8 line 33).

At the time the invention was made, it would have been obvious to include the aforementioned features of Scott within the method taught collectively by Otis and Borghesi with the motivation of extending the life of orbiting satellite and reducing the risk and expense of operations for repairing satellites (Scott; col. 1 lines 47-63).

(B) As per claim 10, Otis and Borghesi fail to expressly disclose moving an unmanned extension spacecraft within proximity of the orbiting satellite, mechanically connecting the extension spacecraft to the orbiting satellite to form a docked satellite-spacecraft

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combination, and moving the satellite-spacecraft combination using the control systems of the extension spacecraft.

Scott discloses providing for launching a SIRE spacecraft, which is unmanned, from earth within proximity of the orbiting satellite, docking the SIRE spacecraft with the target satellite to create a docked combination, and moving the combination using control system of the SIRE spacecraft (Fig. 1-5 and 8, col. 1 lines 22-33, col. 6 line 63 to col. 8 line 33).

At the time the invention was made, it would have been obvious to include the aforementioned features of Scott within the method taught collectively by Otis and Borghesi with the motivation of extending the life of orbiting satellite and reducing the risk and expense of operations for repairing satellites (Scott; col. 1 lines 47-63).

Response to Arguments

8. Applicant's arguments with respect to claims 8-12 have been considered but are moot in view of the new ground(s) of rejection.

(A) In response, all of the limitations which Applicant disputes as missing in the applied references, including the features newly added in the 5 October 2005 amendment, have been fully addressed by the Examiner as either being fully disclosed or obvious in view of the collective teachings of Otis, Borghesi, and/or Scott, based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as detailed in the remarks and explanations given in the preceding sections of the present

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Office Action, and incorporated herein. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references.

See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn Bleck whose telephone number is (571) 272-6767. The Examiner can normally be reached on Monday-Thursday, 8:00am – 5:30pm, and from 8:30am – 5:00pm on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached at (571) 272-6776.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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10. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Or faxed to:

(571) 273-8300 [Official communications]

(571) 273-8300 [After Final communications labeled "Box AF"]

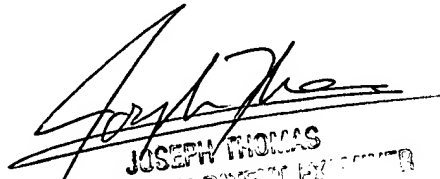
(571) 273-6767 [Informal/ Draft communications, labeled
"PROPOSED" or "DRAFT"]

Hand-delivered responses should be brought to the Knox Building, Alexandria, VA.

CB

CB

December 21, 2005


JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER